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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,158	01/15/2002	Yosato Hitaka	03500.016099	8868

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NEW YORK, NY 10112

EXAMINER

JAIN, ANIL KUMAR

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/045,158

Applicant(s)

HITAKA, YOSATO

Examiner

Anil K. Jain

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) 2,3,8 & 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>march 01 2002</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11-15 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. The print control program claimed is merely a set of instructions per se. Since the program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4-7, 9-12 & 14-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Matsuyama et al. (U. S. Patent 6,886,028).
5. With respect to independent claims 1 & 16, Matsuyama discloses in (Col. 3 line 35, in fig. 1, numeral 101 is an information processing apparatus) an information

processing method (col. 4, line 4, 104) in an information processing apparatus (101) which can communicate with a print management (col. 3, lines 37-39, 101 utilizes a network print service provided via the internet and a network serviced by a print controller 105) apparatus via the Internet, comprising:

A using condition (it is noted that the term using condition is of broad scope and content. As understood, it encompasses a user interface, e.g. a web page being accessed by a user. Clearly Matsuyama inherently discloses this feature, e. g. col. 4, lines 62-66) transmitting step of transmitting using conditions which are inputted (col. 4, lines 62-66, a user interface for a print request is provided, the network peruser 102 is connected across the internet to the print controller 105) to said print management apparatus via the Internet;

A shop information (col. 4, lines 21-25, the individual print servers provide unique services, e.g. special sheet sizes, regular/glossy paper, over the counter delivery, payment methods, etc.) obtaining step of obtaining shop information of a first candidate from said print management apparatus (col. 4, line 20, a printing order received from the print controller 105) in accordance with said using conditions; (col. 4, lines 47-49, in this system, the network peruser 102, which in the client computer 101 is a browser).

A screen information forming step of forming input screen information for promoting selection of a shop (col. 4, lines 26-29, in order to what services are available, during the preparation of a printing order, the client computer 101, must

know which services are provided by which print servers 106, 107 and 108) which is allowed to print and output a print order from the shop information of said first candidate; and a print order transmitting step of transmitting the print order (col. 5, lines 1-4, the print controller 105 detects an output shop at a print server designated in the printing order that is received by the WWW server 109, and registers the output shop in the printing order list) including designation of the selected shop to said print management apparatus via the Internet.

6. With respect to dependent claim 4, Matsuyama discloses in (col. 18 lines 20-25 at step 1603, the application on the computer 101, requests that the document editor 104 generates network printing data for a document that is being edited) method according to claim 1, further comprising a print order forming step of forming a print order for making a print ordering to said print management apparatus on the basis of print target data formed by an application.

7. With respect to dependent claim 5, see the rationale provided in the rejection of claim 1. Matsuyama further shows, a printer information obtaining step of obtaining a printer information description file from said print management apparatus via the internet; in (col. 8, lines 21-26, at step 505 the file from WWW server 109, is transmitted to 102 as a result of the activation of the print server information download program in the print controller 105, and operation of print server information download function editor 103 is initiated).

And wherein in said print order forming step, the print order is formed on the basis of a print setting (col. 17, lines 61-66, fig. 16 is a flowchart showing the network printing processing performed using the network peruser 102. At step 1601, when a user selects a network print command in the document editor 104, the document editor issues a request for the printing of a document) described in the obtained printer information description file.

8. With respect to independent claim 6, see the rationale provided in the rejection of claim 1. Matsuyama further discloses in (Col. 5 line 36-43, fig. 2 illustrating the client computer 101 showing CPU controls the entire apparatus which includes a RAM 1002, and a ROM 1003, which stores system program for controlling devices in the print server) a memory medium, which stores a print control program, which can be executed by an information processing apparatus, which can communicate with a print management apparatus via the Internet.

9. With respect to dependent claim 7, further to the rejection of claim 6, see the rationale provided in rejection of claim 2.

10. With respect to dependent claim 9, further to the rejection of claim 6, see the rationale provided in rejection of claim 4.

11. With respect to dependent claim 10, further to the rejection of claim 9, see the rationale provided in rejection of claim 5.

12. With respect to independent claim 11, see the rationale provided in rejection of claims 1 and 6.

13. With respect to dependent claim 12, further to the rejection of claim 11, see the rationale provided in rejection of claim 2.

14. With respect to dependent claim 14, further to the rejection of claim 11, see the rationale provided in rejection of claim 4.

15. With respect to dependent claim 15, further to the rejection of claim 14, see the rationale provided in rejection of claim 5.

***Allowable Subject Matter***

16. Claims 2, 3, 8 & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Prior art fails to mention 'display of the first candidate left out of said second candidate so that it cannot be selected'.

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anil K. Jain whose telephone number is 571-272-5510. The examiner can normally be reached between the hours of 7:00 and 3:30, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AJ  
October 18, 2005



MARK ZIMMERMAN  
SUPERVISORY PATENT EXAMINER  
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